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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,581	06/11/2001	Susumu Nakagawa	450100-03278	2762
20999	7590	09/13/2005	EXAMINER	
FROMMERM LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			SHANNON, MICHAEL R	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/878,581	NAKAGAWA, SUSUMU
Examiner	Art Unit	
Michael R. Shannon	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 13 June 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-22 and 28-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-22 and 28-30 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 11 June 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) Paper No(s)/Mail Date. ____ .
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) 5) Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date 20050228 6) Other: ____ .

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I claims 1-22 and 28-30 in the reply filed on June 13, 2005 is acknowledged. Non-elected claims 23-27 and 31 are acknowledged as being cancelled.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-22 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Hite et al (USP 5,774,170), cited by Examiner.

Regarding claim 1, the claimed "image content providing method of providing an image content from an image content providing apparatus to an image content reproducing apparatus" is met as follows:

- The claimed step of "requesting to distribute said image content from said image content reproducing apparatus to said image content providing apparatus" is met by column 7, lines 54-63, which disclose a consumer request for programming which can begin at any time. The consumer location meets the claimed reproducing apparatus and the server meets the claimed content providing apparatus.

- The claimed step of "transmitting said image content to said image content reproducing apparatus and detecting a position of inserting an advertisement image in said image content at said image content providing apparatus" is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63].
- The claimed step of "requesting an advertisement image providing apparatus having said advertisement image to distribute said advertisement image from said image content providing apparatus" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD (Recording Device for recording CID codes that tell the display which commercials to display and which commercials to ignore) match .
- The claimed step of "selecting said advertisement image to be inserted to said image content and transmitting thereof to said image content providing apparatus at said advertisement image providing apparatus" is, again, met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the

server if the CID code in the commercial and the CID code in the RD match.

- The claimed step of “distributing said advertisement image at the position of inserting said advertisement image when said image content is distributed from said image content providing apparatus to said image content reproducing apparatus” is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9].

Regarding claim 2, the claimed “image content providing method according to claim 1, wherein when said image content is requested to distribute at said image content reproducing apparatus, said image content is selected and requested to distribute based on a title list which is information for viewing said distributable image contents to be transmitted from said image content providing apparatus” is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the video.

Regarding claim 3, the claimed “image content providing method according to claim 1, wherein the position of said image content for inserting said advertisement image is detected based on advertisement inserting condition data having an advertisement image inserting position condition for designating the position of inserting

said advertisement image and an advertisement image selecting condition for designating a category of said advertisement image capable of being inserted to said image content" is met by the conditions and rules for displaying the commercial [col. 7, lines 7-9].

Regarding claim 4, the claimed "image content providing method according to claim 3, wherein said advertisement inserting condition data includes an advertisement image reproducing condition for designating a maximum period of time for reproducing said advertisement image when said advertisement image is inserted to said image content" is met by the time period disclosed in column 7, lines 22-23. In other words, addressable ads are run for a time period that is designated according to a targeted addressable ad spot.

Regarding claim 5, the claimed "image content providing method according to claim 3, wherein when said advertisement image is requested to distribute at said image content providing apparatus, said advertisement inserting condition data is transmitted to said advertisement image providing apparatus and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said advertisement inserting condition data" is met, again, by the conditions and rules for displaying the commercial. The codes of the commercials transmitted are first compared to the codes previously stored. The commercial transmitted that is found to match is stored in the storage at the display site. Note that the CIDs and display rules would be stored in a storage known as an Ad Queue in the commercial processor [col. 7, lines 7-14].

Regarding claim 6, the claimed "image content providing method according to claim 1, wherein when said image content is requested to distribute at said image content reproducing apparatus, viewer information of a viewer for utilizing said image content is transmitted to said image content providing apparatus" is met by the fact that the characteristics of those viewing or hearing the commercials are analyzed and categorized and the results are stored in a Customer Database 128 [col. 9, lines 44-57].

Regarding claim 7, the claimed "image content providing method according to claim 6, wherein when said advertisement image is requested to distribute at said image content providing apparatus, said viewer information is transmitted to said advertisement image providing apparatus and when said advertisement image is selected at said advertisement image providing apparatus, said advertisement image is selected based on said viewer information" is met by the programming being analyzed and categorized to determine the suitability of insertion of different categories of commercials [col. 9, lines 44-57]. Also, the Programming Database 152 contains lists of programs which would be suitable and eligible for use with commercials which match the needs and wants of consumers in the Consumer Database 128 [col. 11, lines 13-18].

Regarding claim 8, the claimed "image content providing method according to claim 1" is further met as follows:

- The claimed "main image content distributing apparatus" is met by the Media Origination Facility 300.
- The claimed "plurality of deputy image content distributing apparatus" is met by Ad Administration and Transmission Facilities 100 and 200.

- The claimed "wherein said main image content distributing apparatus selects one of the deputy image content distributing apparatus from said plurality of deputy image content distributing apparatus by a request of distributing said image content from said image content reproducing apparatus and said selected deputy image content distributing apparatus distributes said image content to said image content reproducing apparatus" is met by the fact that the Ad Administration Facility 100 is where customers, commercials, and programs are analyzed and categorized and the results are stored in databases. The information is then transmitted to the Ad Transmission Facility 200, which then sends the processed commercials and CID codes with other video and/or audio programming to the Media Origination Facility 300. The Media Origination Facility 300 then sends the processed commercials and CID codes to the display site 400 at user request (as discussed previously) [col. 8, line 65 – col. 9, line 33].

Regarding claim 9, the claimed "image content providing method according to claim 1" is further met as follows:

- The claimed "main image content distributing apparatus" is met by the Media Origination Facility 300.
- The claimed "plurality of image content distribution splitter nodes, wherein when said main image content distributing apparatus is requested to distribute said image content, said main image content distributing

apparatus selects said image content distribution splitter node and distributes said image content to said image content distribution splitter node and said image content is distributed from said image content distribution splitter node to said image content reproducing apparatus" is met by the proposed use of the method of commercial substitution in a geographical node system [col. 3, lines 4-10].

Regarding claim 10, see the above rejection to similar method claim 1.

Regarding claim 11, see the above rejection to similar method claim 2.

Regarding claim 12, see the above rejection to similar method claim 3.

Regarding claim 13, see the above rejection to similar method claim 4.

Regarding claim 14, see the above rejection to similar method claim 5.

Regarding claim 15, see the above rejection to similar method claim 7.

Regarding claim 16, the claimed "image content providing method according to claim 11, wherein said image content is provided by said image content providing apparatus by subjecting said image content to download distribution to said image content reproducing apparatus" is met by the download of the programming and processed commercials and CID codes via electrical and/or optical links 303, radio transmission 302 and 401, or satellite 202 [col. 9, lines 32-38].

Regarding claim 17, the claimed "image content providing method according to claim 11, wherein said image content is provided by said image content providing means by transmitting an information recording medium recorded with said image content to said image content reproducing apparatus" is met by the transmission of the

programming and processed commercials and CID codes via physical means 307 such as optical or magnetic tapes or disks [col. 9, lines 32-38].

Regarding claim 18, the claimed "image content providing system" is met as follows:

- The claimed "image content providing apparatus having an image content and having a function of providing said image content" is met by the Media Origination Facility 300 for sending programming and commercials to display site 400 [col. 9, lines 28-33].
- The claimed "advertisement image providing apparatus having an advertisement image to be inserted to said image content and having a function of providing said advertisement image" is met by the Ad Transmission Facility 200, which combines the commercials and CID codes with other video and audio programming and conveys it to the Media Origination Facility for sending to the display site 400 [col. 9, lines 16-20].
- The claimed "image content reproducing apparatus having a function of reproducing said image content and said advertisement image; wherein said image content providing apparatus has a function of inserting the advertisement image transmitted from said advertisement image providing apparatus to said image content and providing said image content and said advertisement image to said image content reproducing apparatus" is met by the transmission of a default commercial in case a targeted

commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9].

Regarding claim 19, see the above rejection for similar claim 18.

Regarding claim 20, the claimed "image content providing apparatus for providing an image content" is met as follows:

- The claimed "image content database for storing said image content" is met by the Programming Database 152, for storing programs that would be suitable and eligible for use with commercials which match the needs and wants of consumers [col. 11, lines 12-15]. Also, the VOD systems discussed in column 7, lines 54-63 contains massive storage systems called servers for storing programming.
- The claimed "list forming means having a function of forming a title list which is information of viewing said image content stored to said image content database and providing said title list" is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the video.
- The claimed "image providing means having a function of inserting an advertisement image to said image content of said image database and distributing thereof" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial

being sent from the server if the CID code in the commercial and the CID code in the RD match.

Regarding claim 21, the claimed "advertisement image providing apparatus having an advertisement image and providing said advertisement image" is met as follows:

- The claimed "advertisement image database for storing said advertisement image" is met by the Ad Administration Facility 100, which stores commercials and programs for analysis and categorization. The results of which are stored in a database [col. 8, line 65 – col. 9, line 2].
- The claimed "advertisement image selecting means for selecting said advertisement image to be provided from said advertisement image database" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.
- The claimed "advertisement image providing means having a function of providing said advertisement image selected by said advertisement image selecting means and generating an advertisement providing log which is history information when said advertisement image is selected" is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials

could be relatively small...or much larger [col. 6, lines 3-9]. Also, the Ad Administration Facility 100 contains Customer Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

- The claimed "advertisement providing log database for storing said advertisement providing log" is, again, met by the Customer Database 128, which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

Regarding claim 22, the claimed "image content reproducing apparatus for reproducing an image content" is met as follows:

- The claimed "image acquiring means for acquiring said image content and acquiring an advertisement image inserted to said image content" is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63]. Also, the insertion of the advertisement into the image content is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of

simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9].

- The claimed "image reproducing means having a function of reproducing said image content acquired by said image acquiring means and inserting said advertisement image to said image content based on an advertisement inserting condition data and reproducing thereof" is met by the conditions and rules for displaying the commercial instead of the preemptable commercial that is delivered along with the video programming [col. 7, lines 7-14].

Regarding claim 28, the claimed "program storage medium stored with an image content providing program which is a program storage medium stored with an image content providing program for providing an image content" is met as follows:

- The claimed "list forming means having a function of forming a title list constituting information of viewing said image content stored to said image content database and providing said title list" is met by the VOD (Video On Demand) functionality discussed on column 7, lines 54-63, which inherently allows users to select programming from a title list that is transmitted to the display site before transmission of the video.
- The claimed "image providing means having a function of inserting an advertisement image to said image content of said image content database and distributing thereof" is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the

commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.

Regarding claim 29, the claimed “program storage medium stored with an advertisement image providing program which is a program storage medium stored with an advertisement image providing program for providing an advertisement image” is met as follows:

- The claimed “advertisement image selecting means for selecting said advertisement image to be provided from an advertisement image database” is met by column 6, lines 28-33, which disclose that the display site tunes to the frequency which contains the commercial being sent from the server if the CID code in the commercial and the CID code in the RD match.
- The claimed “advertisement image providing means having a function of providing said advertisement image selected by said advertisement image selecting means and generating an advertisement providing log constituting history information in providing said advertisement image” is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small...or much larger [col. 6, lines 3-9]. Also, the Ad Administration Facility 100 contains Customer Database 128,

which stores a list of viewer information regarding viewed and possible future commercial interests [col. 10, lines 54-58].

Regarding claim 30, the claimed “program storage medium stored with an image content reproducing program which is a program storage medium stored with an image content reproducing program for reproducing an image content” is met as follows:

- The claimed “image acquiring means for acquiring said image content and acquiring an advertisement image to be inserted to said image content” is met by the routing of the requested video to the individual consumer display device. Detecting a position of inserting an advertisement image is met by the commercial choice being switched to that location based on a match of the CID (Commercial Identifier) determined for that location and the CID embedded in the commercial. The matching can occur at the display site [col. 7, lines 54-63]. Also, the insertion of the advertisement into the image content is met by the transmission of a default commercial in case a targeted commercial is not played in place of the default commercial. Depending on the capacity of the transmission system, the number of simultaneous commercials could be relatively small... or much larger [col. 6, lines 3-9].
- The claimed “image reproducing means having a function of reproducing the image content acquired by said image acquiring means and inserting said advertisement image to said image content based on advertisement inserting condition data and reproducing thereof” is met by the conditions

and rules for displaying the commercial instead of the preemptable commercial that is delivered along with the video programming [col. 7, lines 7-14].

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Carles (USP 5,515,098) discloses a system for selectively distributing commercial messages.

Wachob (EP 0 424 648) discloses a system for providing demographically targeted television commercials.

Zigmond et al (USP 6,698,020) disclose techniques for intelligent video ad insertion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon who can be reached at (571) 272-7356 or Michael.Shannon@uspto.gov. The examiner can normally be reached by phone Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
August 8, 2005



JOHN MILLER
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